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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/368,429	08/05/1999	FUMIHIKO YAMAGUCHI	0950-0110P	5516

2292 7590 07/26/2002

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EXAMINER

BEFUMO, JENNA LEIGH

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 07/26/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/368,429

Applicant(s)

YAMAGUCHI ET AL.

Examiner

Jenna-Leigh Befumo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-13 is/are pending in the application.
- 4a) Of the above claim(s) 3,6-9 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,10,12 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Amendment B, submitted as Paper No. 11 on May 16, 2002, has been entered. Claim 4 has been cancelled. Claims 1 and 5 have been amended. Therefore, the pending claims are 1 – 3 and 5 – 13. Claims 3, 6 – 9 and 11 are withdrawn from consideration as being drawn to a non-elected invention.
2. Amendment B is sufficient to the 35 USC 112 2nd paragraph rejection set forth in section 8 of the previous Office Action.
3. Amendment B is sufficient to withdraw the 35 USC 102/103 rejections over Blyth et al. (4,592,940) and Pacifici et al. (5,843,428) since neither reference teaches using a triazine ring containing component in the stain resistant compound. Additionally, the 35 USC 103 rejection to claim 12 over Blyth et al. and Pacifici et al. is also withdrawn.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 1, 2, and 13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over JP 59150175 A or Kato et al. (5,349,003) in view of Pacifici et al. for the reasons of record.
6. Claim 5 stands rejected under 35 U.S.C. 103(a) as being unpatentable over JP 59150175 A in view of Pacifici et al. as applied to claim 1 above, and further in view of Kubo et al. (5,883,175) for the reasons of record.
7. Claims 1, 2, 10, and 13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Amimoto et al. (5,143,991) in view of Kato et al. and Pacifici et al. for the reasons of record.

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8. Claim 12 stands rejected under 35 U.S.C. 103(a) as being unpatentable over JP 59150175 A or Kato et al. (5,349,003) in view of Pacifici et al. as applied to claim 1 above for the reasons of record.

Claim 12 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Amimoto et al. in view of Kato et al. and Pacifici et al. as applied to claim 1 above for the reasons of record.

Response to Arguments

9. Applicant's arguments filed May 16, 2002 have been fully considered but they are not persuasive. The Applicant argues that it would not have been obvious for one of ordinary skill in the art to produce a stain resistant composition comprising a triazine ring based on JP 59150175 A and Pacifici et al. (Amendment B, page 9). This argument is based on the fact that a carpet would not require a seam shift resistance and thus one would not be motivated to use a triazine ring compound. However, based on the English translation of the JP 59150175 A as a whole, JP 59150175 A discloses a composition having high water and oil repellent properties as well as excellent durability. In the first paragraph of page 3, JP 59150175 A discloses that conventional water and oil repellent compositions have a low durability and are removed easily by cleaning the fabric. Then JP 59150175 A discloses that using a triazine ring containing compound improves the durability of the water and oil repellent compositions. The additional properties such as seam shift resistance produced by the composition would not teach away from using the triazine ring containing compound on a carpet since the seam shift resistance property would not negatively effect the carpet after it has been applied, while the positive influence of the triazine ring, i.e., the improved durability, would produce a carpet with better stain resistance. Hence, there is no reason not to apply the triazine ring containing compound to a carpet.

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10. Further, the Applicant argues that one of ordinary skill would not be motivated to remove the urea or urethane compounds taught by JP 59150175 A from the composition (Amendment B, pages 9 – 10). However, the invention as claimed does not require that the urea or urethane compounds are removed from the composition. The Applicant has claimed that the stain resistant composition “comprises” a fluoroalkyl-containing compound and a triazine ring-containing compound. Hence, the composition can have other compounds besides those claimed by the Applicant and therefore, the compound taught by JP 59150175 A does not need to teach removing the urea or urethane compounds. Additionally, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., lack of urea or urethane compounds in the stain-resistant composition) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Thus, the rejection is maintained.

11. With respect to the rejection based on Kato in view of Pacifici et al., the Applicant argues that it would not be obvious to remove the monomer mixture taught by Kato et al. since it is essential to the end properties of the stain-resistant composition (Amendment B, pages 11 – 12). As set forth above, the composition is claimed using the term “comprising”. Thus, the prior art can contain additional elements not claimed by the Applicant. Further, the Applicant has not claimed that the monomer mixture cannot be present in the stain-resistant composition. Additionally, the Applicant states that the composition of the present Applicant has unexpected superior results. However, it is unclear how or why the results are superior since the Applicant

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has not shown any results which compare the composition taught by the Applicant directly to the composition taught by Kato combined with Pacifici. Therefore, the rejection is maintained.

12. The Applicant argues that claim 5 should not be rejected based on JP 59150175 A or Kato et al. in view of Pacifici et al. since the Applicant argues that the combination of references fails to render obvious the composition recited in claim 1. However, as set forth above, the rejection based on JP 59150175 A or Kato et al. in view of Pacifici et al. is maintained.

Therefore, claim 5 is still rejected for the reasons of record.

13. Finally, the Applicant argues that the composition taught by Amimoto et al. requires four different components and it would not have been obvious to one of ordinary skill in the art to remove any of the four components. However, since the Applicant claims the composition using open language additional components can be present in the prior art. As set forth above, the use of additional components by the prior art does not render a claim unobvious, since the Applicant has failed to claim that those additional components cannot be present in the stain-resistant composition. Further, the arguments that the composition taught by the Applicant has unexpected superior results is unclear, since the Applicant has not compared the Applicant's composition to the composition produced by the combination of the Amimoto, Kato and Pacifici. Thus, the rejections are maintained.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenna-Leigh Befumo whose telephone number is (703) 605-1170. The examiner can normally be reached on Monday - Friday (9:00 - 5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Jenna-Leigh Befumo
July 21, 2002



TERREL MORRIS
SUPERVISORY PATENT EXAMINER
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